

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Kazuo ASAKA et al.

Group Art Unit: 2832

Application No.: 10/571,792

Examiner: R. BARRERA

Filed: March 15, 2006

Docket No.: 127371

For: SINTERED PLUNGER AND PRODUCTION METHOD THEREFOR

**SUPPLEMENTAL RESPONSE TO RESTRICTION AND ELECTION OF SPECIES
REQUIREMENT**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In reply to the October 8, 2008 Restriction and Election of Species Requirement (Requirement), and further to the November 10, 2008 Response to Restriction and Election of Species Requirement, Applicants provisionally elect Group I, claims 1-7 with traverse. In contrast to the November 10 Response, Applicants now provisionally elect Species IB (Fig. 2B), Species IIA (tool steel) and Species IIID (Fe-Si-P based alloy) with traverse. At least claims 1-7 read on the elected species.

National stage applications filed under 35 U.S.C. §371 are subject to unity of invention practice as set forth in PCT Rule 13, and are not subject to U.S. restriction practice. *See* MPEP §1893.03(d). PCT Rule 13.1 provides that an "international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept." PCT Rule 13.2 states:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention

referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

I. Restriction

A lack of unity of invention may be apparent "*a priori*," that is, before considering the claims in relation to any prior art, or may only become apparent "*a posteriori*," that is, after taking the prior art into consideration. *See* MPEP §1850(II), quoting *International Search and Preliminary Examination Guidelines* ("ISPE") 10.03. Lack of *a priori* unity of invention only exists if there is no subject matter common to all claims. *Id.* If *a priori* unity of invention exists between the claims, or, in other words, if there is subject matter common to all the claims, a lack of unity of invention may only be established *a posteriori* by showing that the common subject matter does not define a contribution over the prior art. *Id.*

Independent claim 8 is a production method for a sintered plunger, the plunger having a structure as recited in independent claim 1. Accordingly, all the claims share common subject matter and, therefore, *a priori* unity of invention exists between all the claims. Thus, for the present application, a lack of unity of invention may only be determined *a posteriori*, or in other words, after a search of the prior art has been conducted and it is established that all the elements of the independent claim are known. *See* ISPE 10.07 and 10.08.

No reference is provided that discloses that each and every element of the subject matter common to independent claims 1 and 15 is known in the prior art. The general assertion that "Group I lacks the particulars of the method" as argued in the Office Action is insufficient. Therefore, Applicants respectfully submit that lack of unity of invention has not been established, and thus a Restriction Requirement based on a lack of unity of invention is improper.

II. Election of Species

Unity of invention only needs to be determined in the first place between independent claims, and not the dependent claims, as stated in ISPE 10.06:

Unity of invention has to be considered in the first place only in relation to the independent claims in an international application and not the dependent claims. By "dependent" claim is meant a claim which contains all the features of one or more other claims and contains a reference, preferably at the beginning, to the other claim or claims and then states the additional features claimed (Rule 6.4).

See also MPEP §1850(II). ISPE 10.07 further provides:

If the independent claims avoid the prior art and satisfy the requirement of unity of invention, no problem of lack of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention (emphasis added).

See also MPEP §1850(II).

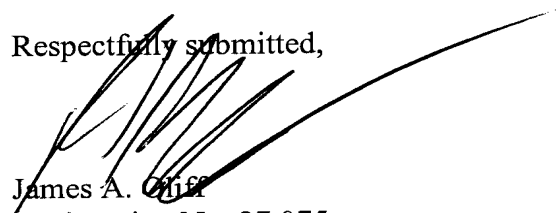
The Requirement asserts that Fig. 2A and 2B (Species I), the tool steel, bearing steel and martensitic stainless steel (Species II) and the ferrite, Fe-P based alloy, Fe-Si based alloy, Fe-Si-P based alloy, permalloy, permendur and "electromagnetic stainless" (Species III) do not relate to a single inventive concept. However, Applicants respectfully assert that claims 2-7 recite the above features, and these claims depend from independent claim 1. Therefore, because claims 2-7 depend from independent claim 1, which is generic, claims 2-7 relate to a single inventive concept.

The Requirement also asserts that the above species do not form a single general inventive concept because the above features allegedly "lack the same structure or the same chemical composition" (see Requirement, page 4). However, as discussed above, the species need not disclose the same structure or composition, but only need to have a technical relationship with one another. The structures of Species I share the common technical feature of a non-magnetic steel shaft being inserted into an outer member composed of a soft

magnetic material and the shaft and the outer member are integrally bonded by sintering. The materials of Species II are examples of a ferromagnetic steel shaft material, which is merely exemplified and claimed within the same claim (claim 3) as the other materials listed in Species II. The materials of Species III are examples of a soft magnetic material which is also merely exemplified and claimed within the same claim (claim 6) as the other materials listed in Species III. Therefore, all species share a technical feature with one another and should not be withdrawn from examination.

The Examiner is respectfully requested to reconsider and withdraw the Restriction and Election of Species Requirement and to examine all of the species and claims in this application.

Respectfully submitted,


James A. Oliff
Registration No. 27,075

Patrick T. Muffo
Registration No. 60,342

JAO:PTM/hs

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OLIFF & BERRIDGE, PLC
P.O. Box 320850
Alexandria, Virginia 22320-4850
Telephone: (703) 836-6400

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